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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 24

Application Number: 09/472,197

Filing Date: December 27, 1999

Appellant(s): GARDENSWARTZ ET AL.

Mr. Robert C. Mattson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 07 May 2002.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

Appellant stated in the brief that there are no related appeals. A related interference has been declared in application number 08/498,654 filed on July 23, 1998.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments contained in the brief is correct. No amendments after final have been filed.

(5) Summary of Invention

The summary of invention contained in the brief is substantially correct but does not fully comply with rule 37 CFR 192(c)(5) since the summary does not refer to the specification by page and line number, and to the drawing, if any, by reference characters.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 85-86; 87-88; and 89-90 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) ClaimsAppealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

| | | |
|-------------|----------------|--------|
| WO 97/23838 | Scroggie et al | 7-1997 |
| 6,076,069 | Laor | 6-2000 |
| 6,026,370 | Jermyn | 2-2000 |

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5,970,124

Csaszar

10-1999

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 85-90 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims, as presently claimed and best understood were considered in light of the new "Examination Guidelines for Computer-Related Inventions" and were found to be non-statutory.

Discussion of the analysis of the claims under the guidelines follows.

As per Claims 85-90, the claims are directed to a computer readable medium comprising a data structure for storing information. The stored information is deemed to be non-functional descriptive data that cannot exhibit any functional interrelationship with the way in which computing processes are performed and does not constitute a statutory process, machine, manufacture or composition of matter. Examiner further notes that when functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory, however, claims 85-90 do not recite functional descriptive material, only stored data that represents identifier information. Furthermore, when non-functional descriptive data is recorded on some computer-readable medium, it is not structurally and functionally interrelated to the medium but is merely carried by the medium. Thus, claims 85-90 are deemed to be non-statutory.

Claims 85-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scroggie et al, WO 97/23838 in view of Laor, U.S. Patent No. 6,076,069.

As per Claim 85, Scroggie et al disclose a database for storing information readable by a processor for facilitating the delivering a targeted advertisement, comprising a data structure including a field for storing a first identifier corresponding to a first computer associated with a consumer in the form of an e-mail address (Page 14 line 24-Page 15 line 10; Page 20 line 16-Page 21 line 30) and a field for storing a second identifier associated with the first identifier and corresponding to an observed offline

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purchase history of the consumer, the purchase history including information of an offline purchase of the consumer collected at a point of sale when the offline purchase transpired (Page 6, lines 12-25; Page 19 line 15-Page 20 line 15). Although Scroggie et al teaches a first identifier corresponding to a first computer associated with a consumer in the form of an e-mail address, Scroggie et al, however, fails to specifically disclose that the first identifier identifies a specific computer. *Laor* discloses a method and system for distributing and redeeming electronic coupons and teaches that it has become common practice for a provider of information to use identifiers such as cookies as a means of identifying or recognizing a client and providing some pre-determined level of customization during subsequent requests (Col. 1, lines 23-40). Identifiers such as cookies and IP addresses were well known for use in identifying a specific computer at the time of applicant's invention. Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize cookie numbers as a means to identify a computer associated with a consumer since cookies were well known for providing this type of identification information. Thus, *Laor* provides motivation by indicating that cookies are commonly used to identify or recognize a client and providing some level of pre-determined and pre-programmed level of customization at the discretion of the information provider.

As per Claim 86, Scroggie et al further disclose wherein the second identifier comprises a shopper card identification code of the consumer (Page 6, lines 12-25; Page 19 line 25-Page 20 line 5). Scroggie et al further discloses a first identifier corresponding to a first computer associated with a consumer by using an e-mail address identifier (Page 14 line 24-Page 15 line 10; Page 20 line 16-Page 21 line 30), however, fails to specifically disclose that the first identifier is a cookie number. *Laor* discloses a method and system for distributing and redeeming electronic coupons and teaches that it has become common practice for a provider of information to use cookies as a means of identifying or recognizing a client and providing some pre-determined level of customization during subsequent requests (Col. 1, lines 23-40). Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize cookie numbers as a means to identify a computer associated with a consumer since cookies were well known for providing this type of identification information. Thus, *Laor*

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provides motivation by indicating that cookies are commonly used to identify or recognize a client and providing some level of pre-determined and pre-programmed level of customization at the discretion of the information provider.

Claim 87 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Scroggie et al*, WO 97/23838 in view of *Jermyn*, U.S. Patent No. 6,026,370.

As per Claim 87, *Scroggie et al* disclose a field for storing a first identifier corresponding to a first computer and associated with an observed offline purchase history of a consumer, the purchase history including information of an offline purchase of the consumer collected at a point of sale when the offline purchase transpired (Page 19 line 14-Page 21 line 30). *Scroggie et al* fails to disclose a field for specifically storing a purchase behavior classification based on the purchase history. *Jermyn* discloses a technique for customizing purchase incentives for selected consumer households based on the detailed purchasing history and the consumer profile or classification also based on the purchasing history (Col. 2, lines 16-22 and 49-54; Col. 7, lines 20-30 and 40-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include a consumer classification in the database taught by *Scroggie et al* so that consumers could be targeted with specific incentives based on their associated category as suggested by *Jermyn* (Col. 2, lines 15-20 and 49-54). The motivation would be to provide an advantage and benefit to the consumer in that they would be presented incentives that they would most likely be interested in.

Claims 89-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Scroggie et al*, WO 97/23838 in view of *Csaszar et al*, U.S. Patent No. 5,970,124.

As per Claims 89-90, *Scroggie et al* disclose a database for storing ID numbers corresponding to customers (Page 19 lines 14-30) and targeting purchase incentives to specific customers based upon the observed offline purchase history of the customer, the purchase history including information of a

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purchase of the customer collected at a point of sale when the purchase transpired (Page 20 line 9-Page 21 line 15) wherein the identifiers are readable by a processor for facilitating the delivery of the targeted advertisements. *Scroggie et al*, however, fail to specifically disclose an identifier corresponding to the targeted interactive voice response message. *Csaszar et al* disclose a database containing attributes of a consumer and targeted messages that an interactive voice response system can deliver to a consumer based on the consumer attributes (Abstract; Col. 1 line 61-Col. 2 line 7, Col. 2, lines 18-25 and Col. 2 line 51-Col. 3 line 5). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the database of *Scroggie et al* and include the capability to store identifiers for targeted messages and deliver these messages via an interactive voice response system to the consumer as an alternate means to present targeted advertisements to consumers who may not have access to a computer. *Csaszar et al* also provides motivation by indicating that an advantage of interactive voice response systems is that they can deliver information that consumers desire at any time and at low cost (Col. 2, lines 35-37).

Claim 88 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Scroggie et al*, WO 97/23838 and *Jermyn*, U.S. Patent No. 6,026,370 as applied to claim 87 above, and further in view of *Laor*, U.S. Patent No. 6,076,069.

As per claim 88, *Scroggie et al* further discloses a first identifier corresponding to a first computer associated with a consumer by using an e-mail address identifier (Col. 9, lines 29-40; Col. 12 line 53-Col. 13 line 23) however, fails to specifically disclose that the first identifier could be a cookie. *Laor* discloses a method and system for distributing and redeeming electronic coupons and teaches that it has become common practice for a provider of information to use cookies as a means of identifying or recognizing a client and providing some pre-determined level of customization during subsequent requests (Col. 1, lines 23-40). Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize cookie numbers as a means to identify a computer associated with a consumer since cookies were well known for providing this type of identification information. Thus, *Laor* provides motivation by indicating that cookies are commonly used to identify or recognize a client and providing

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some level of pre-determined and pre-programmed level of customization at the discretion of the information provider.

(11) Response to Argument

First Issue

Regarding the 35 USC § 101 rejection outlined in the above, applicant asserts that the Examiner has not given due consideration to the amendment filed on 01 October 2001. Examiner respectfully disagrees and notes that full consideration was given to this amendment.

Applicant asserts that claims 85-90 have been amended to recite information that directs or causes a computer to perform a functional operation by reciting that the stored data is readable by at least one processor to automatically deliver a targeted advertisement to the first computer. Examiner has considered this amendment to the claims, however, submits that this amendment does not make the claims statutory.

Examiner submits that the claims are structured in terms of a data structure per se that is embodied on a computer readable medium. The claims do not recite that the data structure is a computer program or instructions executable by a computer system to perform some function. The data structure, as currently claimed, comprises two data fields and is nothing more than a template for storing non-functional data. The claims further recite that the two fields are used for storing information, however, do not recite that data or information is actually stored in these fields. Examiner submits that the data fields represent identifier information that is used for identifying a computer or a person and cannot, by itself, impart any functional interrelationship with the way in which computing processes are performed. In other words, the stored information representing identification information does not cause or direct a computer to perform any functional operation and thus, is deemed to be non-functional descriptive material and non-statutory. In order for any functionality to be performed, the claimed processor would have to rely on a computer program and execute instructions to act upon the data, thus rendering the stored information unusable without the use of such a computer program. According to the Manual or Patent Examining Procedure, MPEP § 2106, where certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data are merely

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stored so as to be read or outputted by a computer without creating any function interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer.

Examiner further notes that when functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory, however, claims 85-90 do not recite functional descriptive material, only stored data that represents identifier information.

Applicant further submits that the stored data is functional in and of itself by arguing that the stored data is computer readable and therefore a functional relationship exists among the data and the processor reading the data. Examiner respectfully disagrees with this assertion. Examiner submits that just because stored data is capable of being read by a computer or processor does not make it functional. The first identifier identifying a computer and second identifier corresponding to an offline purchase of the consumer, for example, could possibly be nothing more than text, a number or some other alphanumeric and cannot, by itself, impart any functional interrelationship with the way in which computing processes are performed unless interpreted by some program or computer executable instructions executed by a computer or processor. The claims in question recite nothing more than a data structure having two fields which are used for storing information. Whether or not the stored data can be read by a processor is irrelevant and is directed to the manner in which the data is intended to be used.

Second Issue

Applicant states that the Examiner must explain the reasons why one of ordinary skill in the art would have been motivated to select and combine the particular applied references of Scroggie et al and Laor. Applicant further argues that the Laor reference merely teaches the use of cookies to deliver coupons and that there is no motivation to combine the references. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed

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invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Scroggie et al teaches a method of using the observed offline purchase history of the consumer to automatically deliver targeted advertisements to consumers on the basis of their observed offline purchase history. Scroggie et al further teaches that the advertisements are sent to the consumer using their e-mail address. Examiner agrees that the use of an e-mail address disclosed by Scroggie et al is not used to identify a computer, but rather a consumer. However, Examiner submits that it would have been obvious to identify the computer associated with the consumer through other means of identifying computers such as the use of cookies or IP addresses, and send an advertisement to the consumer based on a cookie or IP address, as taught by Laor, rather than using an e-mail address. Laor provides motivation by indicating that consumers or computers associated with consumers can be identified through the use of cookies and indicating that this will enable an information provider such as an a vendor to recognize the consumer and provide some pre-determined and pre-programmed level of customization at the discretion of the information provider (Col 1, lines 24-56). In fact, Laor also discloses that coupons could be communicated to the consumer using electronic mail (Col. 5, lines 45-55). Examiner believes this is clear evidence that the use of cookies to identify a computer associated with a consumer was known at the time of applicants invention and that it would have been obvious to one of ordinary skill in the art to use cookies as a means to identify a computer associated with a consumer rather than using an e-mail address.

In conclusion, Examiner is not asserting that the references of Scroggie et al and Laor were combined to teach the use of the consumer's observed offline purchase history in combination with an identifier identifying a computer associated with a consumer to deliver an advertisement. Scroggie et al alone teaches this feature, but uses an e-mail address to identify the consumer rather than a cookie. Laor was combined with Scroggie et al to provide a teaching that using a cookie instead of an e-mail address to identify a computer associated with a consumer would have been obvious to one of ordinary skill in the art at the time of the invention. Examiner further notes that applicant is arguing that the use of

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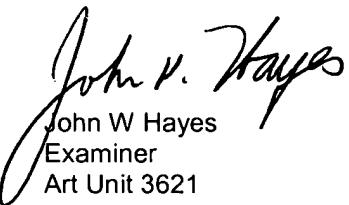
a cookie would not have been obvious, however, there are no recitations of a cookie in any of the independent claims 85, 87 and 89. Recitations that limit the identifier to a cookie are only found in dependent claims 86 and 88.

With respect to the Jermyn and Csaszar et al references, applicant has not provided specific disagreements with the examiner's contentions. Furthermore, applicant has not discussed the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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Examiner
Art Unit 3621

June 26, 2002

Conferees

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